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|-------------------------------------|---|---------------------|
| In re Application of | : | DECISION ON RENEWED |
| David WOESSNER | : | |
| PCT No.: PCT/US03/00977 | : | |
| Application No.: 10/088,181 | : | PETITION UNDER |
| Int. Filing Date: 14 January 2003 | : | |
| Priority Date: 15 January 2002 | : | |
| Attorney's Docket No.: 60158-272 | : | 37 CFR 1.47(b) |
| For: HOUSE IN TUBE FORMING ASSEMBLY | : | |
| AND PROCESS | : | |

This decision is in response to applicant's "PETITION UNDER 37 CFR 1.47(b)" submitted on 24 August 2005 that seeks the acceptance of the application without the signature of Mrs. Woessner, the legal representative of deceased inventor David WOESSNER.

BACKGROUND

In a decision from this office on 24 June 2005, the petition filed on 12 April 2005 was dismissed. The decision stated that items (1)-(2) and (4)-(6) were not satisfied.

On 24 August 2005, petitioner filed the current renewed petition.

DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage.

Applicant has satisfied items (1)-(4) and (6) but not item (5) thus not completing the requirements under 37 CFR 1.47(b).

Applicant has satisfied item (1) since the petition fee has been provided.

Regarding requirement (2), applicant has provided sufficient evidence that Mrs. Woessner, the legal representative of the deceased inventor David Woessner, refuses to sign the declaration. Petitioner on July 11, 2005 emailed Mrs. Woessner the PCT application, a declaration and an assignment for her review and signature. On July 12, 2005 Mrs. Woessner expressly refused to sign the required papers as evidenced by her email.

Regarding item (4) a declaration has been provided executed by an appropriate officer of company on behalf of the non-signing legal representative of the deceased inventor.

Regarding item (6) petitioner has presented an adequate showing that the granting of this petition is necessary to preserve the rights of the parties or to prevent irreparable damage.

Regarding item (5) petitioner has still not submitted proof that applicant has sufficient proprietary interest in the application. The court case cited by petitioner and Mr. Zakrzewski statement are helpful but by themselves are not dispositive and are not a substitute for the legal memorandum required when there is no assignment document of the invention by the inventor as discussed in the previous decision and below.

If the invention has not been assigned, or if there is no written agreement to assign, the 37 CFR 1.47(b) applicant must demonstrate that he or she otherwise has a sufficient proprietary interest in the matter.

A proprietary interest obtained otherwise than by assignment or agreement to assign may be demonstrated by an appropriate legal memorandum to the effect that a court of competent jurisdiction (federal, state, or foreign) would by the weight of authority in that jurisdiction award title of the invention to the 37 CFR 1.47(b) applicant. The facts in support of any conclusion that a court would award title to the 37 CFR 1.47(b) applicant should be made of record by way of an affidavit or declaration of the person having firsthand knowledge of same. The legal memorandum should be prepared and signed by an attorney at law familiar with the law of the jurisdiction involved. A copy (in the English language) of a statute (if other than the United States statute) or a court decision (if other than a reported decision of a federal court or a decision reported in the United States Patents Quarterly) relied on to demonstrate a proprietary interest should be made of record.

Accordingly, it is not appropriate to accord the national stage application status under 37 CFR 1.47(b) at this time.

CONCLUSION

The petition under 37 CFR 1.47(b) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Second Renewed Petition Under 37 CFR 1.47(b)." Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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